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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/592,462	06/09/2000	Tracy E. Grim	480032-307	4478

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EXAMINER

PATTERSON, MARIE D

ART UNIT PAPER NUMBER

3728

DATE MAILED: 10/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/592,462

Applicant(s)

GRIM ET AL.

Examiner

Marie Patterson

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23, 33-50, 53-58 and 67-81 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-23, 33-36, 38, 74, 75 and 77 is/are allowed.
- 6) ☒ Claim(s) 37, 39-50, 53-58, 67-73, 76, and 78-81 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

Reissue Applications

1. Claims 37, 39-50, 53-58, 67-73, 76, and 78-81 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Claims 37, 39-50, 53-58, 67-73, 76, and 78-81 do not contain the limitations "an inner sole extending substantially over the entire sole area" and "said grid of resilient sections comprising substantially all of said inner sole and extending over substantially all of said sole area" which were added and argued in the amendment filed 6/17/96 which resulted in the Examiner allowing claim 17, now patented claim 19 which is the broadest claim in the original patent. Therefore, applicant has previously surrendered the subject matter of an inner sole which does not extend substantially over the entire sole area with a grid of resilient sections which does not comprise substantially all of the

inner sole and extends over substantially the entire sole area. It is also noted that these limitations were argued by application for patentability in the amendment filed 6/17/96.

Note MPEP 1412.02 which states "The recapture rule bars the patentee from acquiring through reissue claims that are, in all aspects, of the same scope as, or are broader in scope than, those claims canceled from the original application to obtain a patent. Ball, 729 F.2d at 1436, 221 USPQ at 295." Canceled claim 20 of parent application 08/360798 recited "....an inner sole extending substantially over the entire sole area mounted in said footgear above said outer sole, said inner sole having a plurality of removable sections that are removably mounted in said footgear and that area arranged in a grid pattern, said removable sections having lower surfaces which are removably secured within said footgear and said sections together....said grid...comprising substantially all of said inner sole and extending substantially over the entire sole area.", therefore claims which do not require such are considered to be barred in a reissue application per MPEP 1412.02. Claims 50, 57, 58, 67-73, 76, and 78-81 are considered to be broader or of the same scope as the canceled claim 20 in the prior application and therefore barred.

2. The reissue oath/declaration filed with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414.

3. The reissue Declaration filed with this application is defective (see 37 CFR 1.175 and MPEP 1414) because of the following:

The original Declaration is not relevant to the newly filed claims.

4. It is noted that applicant has requested that the requirement for new Declarations be deferred until claim language is finalized and thus such a requirement is deferred and will be required when the claims are finalized.

Claim Rejections - 35 USC § 112

5. Claims 48-50, and 54-58 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 48-50, 57, and 58 the phrase "sections that sway laterally...." is vague and indefinite because it is not clear what structural limitations applicant intends to encompass with such language. Said phrases also are considered to be functional, indefinite, and incomplete because they contain functional language not supported by recitation in the claim of sufficient structure to warrant the presence of such language.

In claims 50, 57, and 58 the phrase "independently vertically movable resilient sections" is vague and indefinite because it is not clear what structural limitations applicant intends to encompass with such language. There is no structural limitations claimed which facilitate the functional recitation of "vertically movable". In response to applicants' arguments directed towards such, the fact that the sections are made of resilient material does not make them "vertically movable". The top surface of the section make be vertically movable by the resiliency of the sections, however the sections would appear to remain unmoved vertically. Also, it is noted that the claim recited that the sections are "independently vertically movable", what recited structures

allow such a function to occur?, i.e. what structures are intended to be encompassed by such language. If applicant merely intends to encompass that the sections are resilient then why is such a limitation/recitation needed, i.e. what structures are intended to be encompassed.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 50, 54, 55, 56, are rejected under 35 U.S.C. 103(a) as being unpatentable over Kellerman in view of Andrews (4793078).

Kellerman shows footgear comprising a flexible sheet (12 or an insert as discussed in column 8, lines 3-8) and removable resilient sections (34) forming a resilient layer substantially as claimed except for orienting the insert so that the removable resilient sections are an upper layer. Andrews teaches providing an insert with removable resilient sections with the removable sections being the upper layer adjacent a wearer's foot to better relieve pressure at sensitive areas of a wearers' foot. It would have been obvious to provide the removable sections on the upper surface of the insole/pad as taught by Andrews in the footgear of Kellerman to better relieve pressure at regions of swelling, pain, or inflammation (as discussed in Kellerman in column 6 lines 4-7) and to

provide better shock absorption and cushioning and to conform the insole to "suit the user's requirements" (column 2 lines 21-22).

Allowable Subject Matter

8. Claims 1-23, 33-36, 38, 74, 75, and 77 are allowed.
9. Claims 37, 39-47, 53, 57, 67-73, 76, and 78-81 would be allowed if amended to overcome the recapture rejection.
10. Claims 48, 49, and 58 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph and the recapture rejection set forth in this Office action.

Response to Amendment

11. The Declaration under 37 CFR 1.132 filed 3/17/03 and letter filed 4/18/03 is insufficient to overcome the rejection of the claims as set forth in the last Office action because: There has been no designation of nexus between the Long Declaration and the claims as required by MPEP 716.03. Also, See also *Pentec, Inc. v. Graphic Controls Corp.*, 776 F.2d 309, 227 USPQ 766 (Fed. Cir. 1985) (commercial success may have been attributable to extensive advertising and position as a market leader before the introduction of the patented product); *In re Fielder*, 471 F.2d 690, 176 USPQ 300 (CCPA 1973) (success of invention could be due to recent changes in related technology or consumer demand; here success of claimed voting ballot could be due to the contemporary drive toward greater use of automated data processing techniques); *EWP Corp. v. Reliance Universal, Inc.*, 755 F.2d 898, 225 USPQ 20 (Fed. Cir. 1985)

(evidence of licensing is a secondary consideration which must be carefully appraised as to its evidentiary value because licensing programs may succeed for reasons unrelated to the unobviousness of the product or process, e.g., license is mutually beneficial or less expensive than defending infringement suits); *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 231 USPQ 81 (Fed. Cir. 1986). **SALES FIGURES MUST BE ADEQUATELY DEFINED** Gross sales figures do not show commercial success absent evidence as to market share, *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015, 226 USPQ 881 (Fed. Cir. 1985), or as to the time period during which the product was sold, or as to what sales would normally be expected in the market, *Ex parte Standish*, 10 USPQ2d 1454 (Bd. Pat. App. & Inter. 1988)

Response to Arguments

12. Applicant's arguments filed 9/2/03 have been fully considered but they are not persuasive.

In response to applicants' arguments directed towards the recapture rejection based on 35 USC 251, the added limitations to the claims, i.e. the height limitation or means for swaying limitations, are not related to the subject matter previously surrendered by applicant (as noted above in paragraph 1 above) and therefore recapture exists, even though the replacement limitation is a narrowing limitation. See *In re Clement*, 131 F.3d at 1470, 45 USPQ2d at 1165. In the prosecution of an application, a claim limitation which has been added and/or argued by applicant to make the claims allowable over an

art rejection resulting in the claims being allowed, results in the subject matter omitting such a limitation being surrendered. In a later application requesting reissue of that patent, applicant cannot then omit or eliminate that limitation. Claim subject matter which omits that limitation has been surrendered in the prosecution of the original application and applicant cannot then recapture that claim subject matter by way of reissue. See *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997).

In response to applicants' arguments directed towards the 112 rejections directed towards language relating to the "sway" of the elements, it is noted that this rejection has been overcome and withdrawn in the claims which applicant has invoked the 112 sixth paragraph use of "means" language.

In response to Applicant's arguments directed towards frictional, the limitations on which the Applicant relies (i.e., frictional limitations) are not stated in the claims. It is the claims that define the claimed invention, and it is claims, not specifications that are anticipated or unpatentable. *Constant v. Advanced Micro-Devices Inc.*, 7 USPQ2d 1064. In response to applicants' arguments directed towards the coefficient of friction of the sections of Kellerman, there is nothing in applicants' claims which require otherwise. It is the claims that define the claimed invention, and it is claims, not specifications that are anticipated or unpatentable. *Constant v. Advanced Micro-Devices Inc.*, 7 USPQ2d 1064.

In response to applicants' arguments directed towards the "swaying" of the sections, the cited references and rejection above show all of the positively recited structures and are inherently capable of performing the recited function of swaying inasmuch as the


claims have defined such. The sections of Kellerman and/or Andrews are clearly capable of swaying due to the sections being separate and independent. The fact that these sections are thin, there is no thickness requirement in the rejected claims, and the thin sections of the prior art are clearly capable of "swaying" to some degree.

1. Telephone inquiries regarding the status of application or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the Examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148 or the **Tech Center 3700 Customer Service Center number is (703) 306-5648**. For applicant's convenience, the Group Technological Center FAX number is (703) 872-9302. (Note that the Examiner **cannot** confirm receipt of faxes) Please identify Examiner ____ of Art Unit ____ at the top of your cover sheet of any correspondence submitted.

Inquiries only concerning the **merits** of the examination should be directed to Marie Patterson whose telephone number is (703) 308-0069.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g. copies of references cited, form PTO-1449, for PTO-892, etc. requests for copies of such papers should be directed to (703) 308-1337.

Check out our web-site at "www.uspto.gov" for fees and other useful information.


Marie Patterson
Primary Examiner
Art Unit 3728